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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,373	05/31/2000	CHRISTOPHER D. BLAIR	105732	1323

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ALEXANDRIA, VA 22320

EXAMINER

BLACKWELL RUDASIL, GWENDOLYN A

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 10/01/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/584,373	Applicant(s) BLAIR ET AL.	
	Examiner Gwendolyn A. Blackwell-Rudasill	Art Unit 1775	

-- Th MAILING DATE of this communication app ars on th cover sh t with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 27-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-26 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 3,4,6-10 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims setting forth physical characteristics in an article, and not setting forth specific compositions, which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart the desired characteristics. *See Ex parte Slob, 157 USPQ 172.*

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

2. Claims 1-2, 5, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent no. 5,697,029, Saitoh et al.

Saitoh discloses a developing roller with a sleeve, which has a coating on the sleeve. The core of the roller can be formed of any desired material. The sleeve can be formed from metals or resins, (column 2, lines 33-41). As set out in Comparative Example 2, the coating can be

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glass, more specifically silicon dioxide, meeting the requirements of claims 1-2, 5, and 11-12, (columns 4-5, lines 66-4).

### *Response to Arguments*

3. Applicant's arguments filed July 15, 2002 have been fully considered but they are not persuasive as to claims 1-2, 5, and 11-12.

Applicant contends that United States Patent no. 5,697,029, Saitoh et al., do not provide for a glass material that can be electrically charged or discharged. In addition, that the glass covered in Comparative Example 2 did not provide satisfactory results and therefore cannot anticipate applicant's claims.

While applicants is correct in that Saitoh et al., do not specifically state that the glass coating of Comparative Example 2 can be electrically charged or discharged, from the language of claim 1 almost any glass would work. In addition, the language of claim 1 does not state that a clear print image needs to be obtained.

Applicant has not demonstrated with evidence that the glass coating of Saitoh et al., would not work according to the claimed limitations of claim 1. Therefore the rejection as to claims 1-2, 5, and 11-12 stands.

### *Allowable Subject Matter*

4. Claim 3-4, 6-10, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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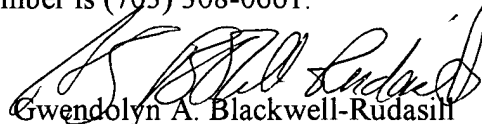
5. Claims 14-26 are allowed as the arguments made in Paper 7 overcome the 35 USC §103(a) rejection made in Paper 5.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn A. Blackwell-Rudasill whose telephone number is (703) 305-9741. The examiner can normally be reached on Monday - Friday; 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Gwendolyn A. Blackwell-Rudasill  
Examiner  
Art Unit 1775

gbr  
September 30, 2002

  
DEBORAH JONES  
SUPERVISORY PATENT EXAMINER